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APR 03 2006

**OFFICE OF PETITIONS**

In re Application of	:	
Gounalis	:	DECISION
Application No. 10/675,541	:	
Filing Date: 30 September, 2003	:	
Attorney Docket No.: L0562.70036US00	:	

This is a revised decision on the petition filed on 3 March, 2006, requesting withdrawal of the holding of abandonment under 37 C.F.R. §1.181—the petition was only received in the Office of Petitions as of this writing.

**NOTE:**      Docketing of Status Inquiries at three- (3-) month intervals following the filing of papers/replies may be prudent practice to demonstrate diligence when lengthy delays occur in matters such as this.

For the reasons set forth below, the petition as considered under 37 C.F.R. §1.181 is **GRANTED.**

**BACKGROUND**

The record reflects that:

- it appeared that Petitioner failed to reply timely and properly to the non-final Office action mailed on 30 August, 2004, with reply due absent and extension of time on or before 30 November, 2004;

- it further appears that Petitioner filed on 3 December, 2004, over a 30 November, 2004, certificate of mailing, an amendment;
- there is a suggestion in the record that a Notice of Informal/Non-Responsive Amendment was mailed on 10 December, 2004, with reply due absent extension of time on or before 10 January, 2005;
- Petitioner filed no reply to the 10 December, 2004, Notice;
- the application went abandoned after midnight 10 January, 2005;
- Petitioner filed a Status Inquiry, to which the Office did not directly respond, on 20 June, 2005;
- the Office mailed the Notice of Abandonment on 12 July, 2005;
- on 12 August, 2005, Petitioner filed the original petition with the allegation that his office had not received the 10 December, 2004, Notice, however, the petition was dismissed on 10 February, 2006, for failure to (a) state that Petitioner had searched the file jacket and found no such document and (b) submit copies of docket records;
- Petitioner has responded to each of those two deficiencies.

It is noted that a review at this writing of the record does not reveal a copy of the 10 December, 2005, Notice. Further, an inquiry to the Examiner and Special Programs Examiner in this regard has produced no response as of this writing.

### STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).<sup>1</sup>

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding

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<sup>1</sup> 35 U.S.C. §133 provides:

**35 U.S.C. §133 Time for prosecuting application.**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.<sup>2</sup>

Delays in responding properly raise the question whether delays are unavoidable.<sup>3</sup> Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).<sup>4</sup> And the Petitioner must be diligent in attending to the matter.<sup>5</sup> Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.<sup>6</sup>))

#### Allegations as to the Request to Withdraw the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.<sup>7</sup>

It appears that Petitioner has satisfied the requirements of the regulation and the case law as discussed above.

### CONCLUSION

Because Petitioner has satisfied the burdens set forth in Delgar v. Schulyer, the petition as considered under 37 C.F.R. §1.181 hereby is **granted**, fees are waived and none have been charged; and the Notice of Abandonment of 12 July, 2005, hereby is **vacated**.

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<sup>2</sup> Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

<sup>3</sup> See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

<sup>4</sup> See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

<sup>5</sup> See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

<sup>6</sup> Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

<sup>7</sup> See: Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).

**The instant matter is released to Technology Center 3600 to remail the Notice of Informal/Non-Responsive Amendment in due course.**

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.

A handwritten signature in black ink, appearing to be "J. Gillon", written in a cursive style.

John J. Gillon, Jr.  
Senior Attorney  
Office of Petitions